RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
<u>EXAMINING GROUP 2623</u>

03500.013894

<u>PATENT APPLICATION</u>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
                                     :   Examiner: C. Kim
Kikuo NAITO   )
                                     :   Group Art Unit: 2623
Appln. No.: 09/409,347   )
                                     :
Filed: September 30, 1999   )
                                     :
For: INFORMATION PROCESSING   )   September 11, 2003
       APPARATUS ENABLING   :
       ELECTRONIC WATERMARKING,   )
       AND COMMUNICATION NETWORK :
       CONNECTABLE TO SUCH   )
       INFORMATION PROCESSING   :
       APPARATUS   )

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>INQUIRY REGARDING STATUS OF AMENDMENT AFTER FINAL REJECTION</u>

Sir:

An Amendment After Final Rejection, including a Petition for Extension of Time and the

required extension fee, was filed on August 12, 2003, in response to the final Office Action

mailed March 12, 2003. To date, Applicant has not received any communication regarding the

Amendment After Final Rejection. Moreover, as of September 11, 2003, the PTO's PAIR

database does not indicate receipt of the August 12, 2003 Amendment After Final Rejection.

Accordingly, Applicant respectfully requests an indication of the status of the

Amendment After Final Rejection and a response thereto. For the PTO's convenience, a copy of

the Amendment After Final Rejection is attached hereto, together with the date-stamped postcard

receipt.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by

telephone at (202) 721-5427. All correspondence should continue to be directed to our below-

listed address.

Respectfully submitted,

Attorney for Applicant
Brian L. Klock
Registration No. 36,570

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
BLK/lmj

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date _8_ / _12_ / _03_
    Mo. Day Yr.

Atty. Docket 03500.013894

Application No. 09/409,347

Sir:
    Kindly acknowledge receipt of the accompanying:

☒ Response to Official Action. _March 12, 2003_

☒ Check for $ _84.00_ (claims fee)

☒ Petition under 37 CFR 1.136 and Check for $ _410.00_

☐ Notice of Appeal and Check for $ _____

☐ Information Disclosure Statement, PTO-1449 and _____ documents

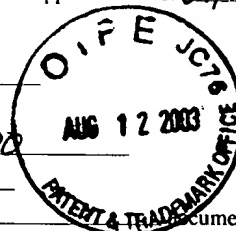☐ Claim for priority and certified copies of _____ priority applications

☐ Issue fee transmittal and Check for $ _____

☒ Other (specify) _Fee Transmittal Sheet_

by placing your receiving date stamp hereon and returning to deliverer.

Atty. _____

Due Date _8_ / _12_ / _03_
    Mo. Day Yr.

FCHS-D-00

In re Application of:

Kikuo NAITO

Application No.: 09/409,347

Filed: September 30, 1999

For: INFORMATION PROCESSING
APPARATUS ENABLING
ELECTRONIC WATERMARKING,
AND COMMUNICATION
NETWORK CONNECTABLE TO
SUCH INFORMATION
PROCESSING APPARATUS

Docket No. 03500.013894

Examiner: C. Kim

Group Art Unit: 2623

Date: August 12, 2003

RECEIVED

SEP 1 6 2003

Technology Center 2600

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment After Final Rejection in the above-identified application.

[ ] Additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	20	MINUS	64	= 0	x $ 9 $18	$ 0.00
INDEP. CLAIMS	7	MINUS	6	= 1	x $42 $84	$84.00
Fee for Multiple Dependent claims $140°/$280						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT---						$84.00

[ ] °Verified Statement claiming small entity status is enclosed, if not filed previously.
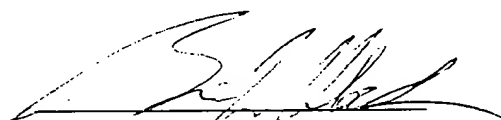
[X] A check in the amount of $ 84.00 is enclosed.

☐ Charge $____·to Deposit Account No. 06-1205. A duplicate copy of this sheet is enclosed.

☒ Any prior general authorization to charge an issue fee under 37 C.F.R. § 1.18 to Deposit Account No. 06-1205 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 06-1205. A duplicate copy of this paper is enclosed.

☒ A check in the amount of $_410.00_ to cover the Extension fee for response within _TWO_ month is enclosed.

☐ A check in the amount of $____ to cover the Information Disclosure Statement fee is enclosed.

☒ Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Attorney for Applicant
Brian L. Klock
Registration No. 36,570

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Page 2 of 2   (August 12, 2003)

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: C. Kim
Kikuo NAITO	)	
	:	Group Art Unit: 2623
Appln. No.: 09/409,347	)	
	:	**RECEIVED**
Filed: September 30, 1999	)	
	:	SEP 1 6 2003
For: INFORMATION PROCESSING	)	August 12, 2003 Technology Center 2600
APPARATUS ENABLING	:	
ELECTRONIC WATERMARKING,	)	
AND COMMUNICATION NETWORK	:	
CONNECTABLE TO SUCH	)	
INFORMATION PROCESSING	:	
APPARATUS	)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT AFTER FINAL REJECTION

Sir:

Petition for Extension of Time

Applicant petitions to extend the time for response to the final Office Action dated

March 12, 2003 for two months from June 12, 2003 to August 12, 2003. A check in the amount

of $410.00 for payment of the extension fee is enclosed. Please charge any additional fee

required for the extension, and credit any overpayment, to Deposit Account 06-1205.

Amendment

In response to the final Office Action dated March 12, 2003, please amend the application as indicated below.

<u>IN THE CLAIMS</u>:

Please amend Claims 1-6, 10, 13-15, 27, 41, 65, and 66 as follows.

Please add new Claim 67 as follows.

1. (Currently Amended) An information processing apparatus comprising:

~~storage means for storing data; and~~

~~setting means for setting a timing for applying an electronic watermark to the data~~ ~~when storing the data in said storage means~~ discrimination means for discriminating, when registering data, timing to apply electronic watermark data, among processes regarding the data; and

registration means for registering the data so that the electronic watermark is applied to the data at the timing discriminated by said discrimination means.

2. (Currently Amended) An information processing apparatus according to claim 1,

wherein said ~~setting means is capable of setting at least a timing for transmitting~~ ~~said data stored in said storage means, and a timing for storing said data in said storage means~~ discrimination means discriminates timing of registering the data or timing after registering the data.

3. (Currently Amended) An information processing apparatus according to claim 1, wherein said ~~setting means is capable of setting at least a timing for outputting said data stored~~

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in said storage means, and a timing for storing said data in said storage means discrimination means discriminates one of timing of registering the data, timing of sending the registered data, or timing of printing the registered data.

4. (Currently Amended) An information processing apparatus according to claim 3, wherein said data is outputted after an 1, further comprising output means for outputting the data after the electronic watermark has been removed from for said data.

5. (Currently Amended) An information processing apparatus according to claim 4 1, further comprising:

display means for providing a display of said data, wherein said display means displays said data to which an electronic watermark is applied print means for printing the data after the electronic watermark has been removed from the data, and

display means for displaying data which the electronic watermark is applied to.

6. (Currently Amended) An information processing apparatus according to claim 3, wherein said data is outputted by using an output device that is capable of communicating with said information processing apparatus timing of printing the data is for sending the data to a printer.

7. (Previously Presented) An information processing apparatus according to claim 6, wherein the electronic watermark is removed from said data by said output device.

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8. (Original) An information processing apparatus according to claim 6, wherein, when the output of said data is completed, said output device deletes data received from said information processing apparatus.

9. (Original) An information processing apparatus according to claim 6, wherein, during the data output process, said output device does not halt said data output process even upon receiving of a halting instruction.

10. (Currently Amended) An information processing apparatus according to claim 1, wherein said ~~setting means is capable of designating one of a plurality of electronic watermarking methods~~ discrimination means further discriminates a method of applying an electronic watermarking method among plurality of electronic watermarking methods.

11. (Original) An information processing apparatus according to claim 10, wherein said plurality of electronic watermarking methods include at the least a first method for employing an electronic watermark as visible information, and a second method for employing an electronic watermark as invisible information.

12. (Original) An information processing apparatus according to claim 10, wherein said plurality of electronic watermarking methods include at the least a third method for employing an electronic watermark as removable information, and a fourth method for employing an electronic watermark as unremovable information.

13. (Currently Amended) An information processing apparatus according to claim 1, wherein said ~~setting means is capable of designating watermark information that is to be applied to said data by said electronic watermarking means, and~~

~~wherein said electronic watermarking means applies, to said data, said watermark information designated by said setting means~~ discrimination means further discriminates electronic watermark information to be applied to the data.

14. (Currently Amended) An information processing apparatus according to claim ~~13, further comprising: management means for managing said watermark information designated by said setting means;~~

~~wherein said electronic watermarking means is capable of employing a plurality of electronic watermarking methods, and~~

~~wherein said management means employs a common form to manage said watermark information, regardless of whether said watermark information has a different form~~ 1, further comprising management means for managing the timing discriminated by said discrimination means for each registered data.

15. (Currently Amended) An information processing system having a plurality of information processing devices, comprising:

~~storage means for storing data, and~~

~~setting means for setting a timing for applying an electronic watermark to the data when storing the data in said storage means~~ discrimination means for discriminating, when

registering data in a predetermined information processing device, timing to apply electronic watermark data, among processes regarding the data; and

registration means for registering the data so that the electronic watermark is applied to the data at the timing discriminated by said discrimination means.

16. - 26. (Canceled)

27. (Currently Amended) A control method for an information processing apparatus comprising:

~~a registration step of registering data in a memory; and~~

~~a setting step of setting a timing for applying an electronic watermark to the data when registering the data in said registration step~~ a discrimination step of discriminating, when registering data, timing to apply electronic watermark data, among processes regarding the data; and

a registration step of registering the data so that the electronic watermark is applied to the data at the timing discriminated in said discrimination step.

28. - 40. (Canceled)

41. (Currently Amended) A control method for a system having a plurality of information processing devices, ~~said control method~~ comprising:

~~a registration step of registering data in a memory; and~~

~~a setting step of setting a timing for applying an electronic watermark to the data when registering the data in said registration step~~ a discrimination step of discriminating, when registering data in a predetermined information processing device, timing to apply electronic watermark data, among processes regarding the data; and

a registration step of registering the data so that the electronic watermark is applied to the data at the timing discriminated in said discrimination step.

42. - 64. (Canceled)

65. (Currently Amended) An information processing apparatus comprising:

~~storage means for storing data;~~

~~electronic watermarking means for applying an electronic watermark to said data;~~

~~communication means for transmitting said data; and~~

~~setting means for designating a timing for applying an electronic watermark to said data among a plurality of timings until the data is transmitted by said communication means~~

discrimination means for discriminating, when registering data, a timing process to apply electronic watermark data among timing of registering the data and timing of sending the registered data; and

registration means for registering the data so that the electronic watermark is applied to the data before registering the data or upon sending the data in accordance with the discrimination by said discrimination means.

66. (Currently Amended) A system having a plurality of information <u>processing</u>

devices, comprising:

~~storage means for storing data;~~

~~electronic watermarking means for applying an electronic watermark to said data;~~

~~communication means for transmitting said data; and~~

~~setting means for designating a timing for applying an electronic watermark to~~

~~said data among a plurality of timings until the data is transmitted by said communication means~~

<u>discrimination means for discriminating, when registering data in a predetermined</u> ·

<u>information processing device, a timing process to apply electronic watermark data among</u>

<u>timing of registering the data and timing of sending the registered data; and</u>

<u>registration means for registering the data so that the electronic watermark is</u>

<u>applied to the data before registering the data or upon sending the data in accordance with the</u>

<u>discrimination by said discrimination means.</u>

67. (New) An information processing apparatus comprising:

registration means for executing a process of registering data; and

instruction means for instructing timing of applying an electronic watermark to

the data among processes regarding the data.

REMARKS

Applicant requests favorable reconsideration and allowance of this application in view of the foregoing amendments and the following remarks.

Claims 1 through 15, 27, 41, and 65-67 are pending in this application, with Claims 1, 15, 27, 41, 65, 66, and 67 being independent.

Claims 1-6, 10, 13-15, 27, 41, 65, and 66 have been amended and Claim 67 has been added. Applicant submits that support for the amendments and the new claim can be found in the original disclosure, and therefore no new matter has been added.

Claim 13 was objected to due to an informality. Applicant submits that the amendments to that claim have obviated the basis for the objection. Withdrawal of the objection is requested.

Claims 1, 10, 13-15, 27, 41, 65, and 66 stand rejected under 35.U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,330,672 (Shur). Claims 2-8, 9, 11, and 12 stand rejected under 35.U.S.C. §103(a) as being variously unpatentable over Shur alone or in combination with U.S. Patent No. 6,233,684 (Stefik) or U.S. Patent No. 6,131,162 (Yoshiura, et al). Applicant respectfully traverses these rejections for the reasons discussed below.

As recited in Claim 1, the present invention includes, *inter alia*, the features of, when registering data, discriminating timing to apply electronic watermark data to the data among processes regarding the data and registering the data so that the electronic watermark is applied at the discriminated timing. In contrast, Shur merely discloses that an electronic watermark can be embedded in an arbitrary position (i.e., at an arbitrary timing) of a bit-stream of data. That patent does not disclose or suggest at least the features of discriminating a timing

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to apply an electronic watermark among processes regarding data being registered and the registering the data so that the electronic watermark is applied at the discriminated timing.

The other cited art also fails to disclose or suggest at least the above-mentioned features and therefore does not remedy the deficiencies of Shur.
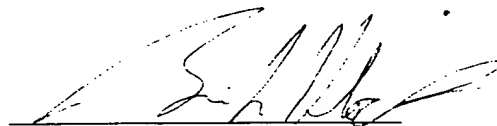
For the foregoing reasons, Applicant submits that the present invention recited in Claim 1 is patentable over the cited art. Independent Claims 15, 27, 41, 65, and 66 recite similar features and are patentable for reasons similar to Claim 1. The dependent claims are patentable for at least the same reasons as the independent claims, as well as for the additional features they recite.

New Claim 67 recites, among others, the feature of instructing timing of applying an electronic watermark to data among processes regarding the data. Applicant submits that the cited art fails to disclose or suggest at least that feature.

In view of the foregoing, this application is believed to be in condition for allowance. Favorable reconsideration, entry of this Amendment After Final Rejection, withdrawal of the objection and rejections, and an early Notice of Allowance are requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 721-5427. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

Attorney for Applicant
Brian L. Klock
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